

**REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-12 are currently pending in this application. No new matter has been added by way of the present amendment. The amendment to claim 1 is supported by Applicants' Specification at, for example, page 14, line 18 to page 17, line 18. New claims 6-12 recite "preferred" features of previously presented claims. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

**Issues Under 35 U.S.C. § 103(a)**

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over either EP 1,172,141 (hereinafter EP '141) or Iwata et al. (U.S. 6,903,048) (hereinafter Iwata '048). Applicants respectfully traverse.

The Examiner asserts that EP '141 discloses an analogous process for the production of a hydrotreating catalyst by employing an impregnating solution containing phosphorous, molybdenum, cobalt and nickel. The Examiner acknowledges that EP '141 fails to disclose the pH and Raman spectrum of the solution employed for impregnation, but asserts that the solution disclosed by EP '141 inherently exhibits these characteristics.

The Examiner further asserts that Iwata '048 discloses an analogous process for the production of a hydrotreating catalyst by employing an impregnating solution containing similar catalyst components. The Examiner acknowledges that Iwata '048 does not disclose the pH and

Raman spectrum, but asserts that "there is nothing unobvious at arriving at the optimum value within a disclosed range".

As to Iwata '048, Applicants submit that this reference is not prior art against the present invention. The effective U.S. filing date of the present application is August 29, 2003. Iwata '408 is not available under 35 U.S.C. 103/102(e) as of its PCT filing date of June 27, 2002, because the international application did not publish in English. Furthermore, the subject matter of Iwata '048 and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Additionally, Applicants submit that Iwata '048 is not available under 35 U.S.C. 103/102(a) because the present invention antedates the publication of the international application. WO 03/002253 (family member of Iwata '048) is available under 35 U.S.C. 102(a) as of its publication date of January 9, 2003. However, the present invention claims priority to JP 2002-252261, filed in Japan on August 30, 2002. A certified English translation of Applicants' priority document (JP 2002-252261) is enclosed. The foreign priority document fully supports the presently pending claims. Accordingly, Applicants submit that neither Iwata '048 nor WO 03/002253 is prior art against the present invention.

As to EP '141, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. EP '141 does not teach or suggest a method for producing a hydrotreating catalyst by bringing a carrying solution into contact with a carrier, wherein the hydrotreating catalyst contains molybdenum, phosphorus, cobalt and nickel. The Examples at pages 4 and 5 of EP '141 disclose the use of catalysts "A" – "F". Among these catalysts, each of Catalysts A, B and D to F uses molybdenum, phosphorus and cobalt, H<sub>2</sub>O<sub>2</sub> and/or organic

acids; and Catalyst C uses only molybdenum, phosphorus and cobalt (see Tables 1 and 2 of EP '141). Therefore, EP '141 does not teach the use of molybdenum, phosphorus, cobalt and nickel, as recited in present claim 1.

Evidently, the cited reference fails to teach or suggest every limitation of the instant invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#### **Claims 6-12**

Claims 6-12 are allowable at least for the reasons set forth above. These claims are further distinguishable from the cited reference for the following reasons. Claim 7 and dependent claims thereof are directed to a method for producing a hydrotreating catalyst by bringing a carrying solution into contact with a carrier, wherein the hydrotreating catalyst contains molybdenum, phosphorus, cobalt and nickel, and does not contain inorganic or organic acids other than phosphoric acid.

Applicants have discovered that a catalyst exhibiting excellent desulfurizing performance can be produced by using a carrying solution which has a specified pH and a specific ratio of molybdenum, cobalt, nickel and phosphorous and no organic or inorganic acids other than phosphoric acid.

Based on the disclosure of EP '141, one skilled in the art would not be motivated to produce a catalyst without organic or inorganic acids, as EP '141 discloses that this results in a reduction in catalyst activity. (see EP '141 at [0033] and Table 1).

**Double Patenting Issues**

Claims 1-5 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 2-10 of Iwata '048. Applicants respectfully traverse.

The Examiner states that a timely filed Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) or (d) may be used to overcome this rejection. Accordingly, enclosed is a Terminal Disclaimer.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

**Conclusion**


All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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Attachments: Verified English Translation of JP 2002-252261  
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